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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,332	10/14/2003	Robert S. Kolman	10030540-1	7202

7590 06/09/2006

AGILENT TECHNOLOGIES, INC.
Legal Department, DL 429
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EXAMINER

BUI, BRYAN

ART UNIT PAPER NUMBER

2863

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/686,332

Applicant(s)

KOLMAN, ROBERT S.

Examiner

Bryan Bui

Art Unit

2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 8-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 8, 9 and 19 is/are allowed.
- 6) ☒ Claim(s) 10-15, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the appeal brief filed on 5/2/2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

John Barlow.

A handwritten signature in black ink, appearing to read 'J. Barlow', is written in a cursive style.

2. Accordingly to reopened prosecution, the amendment response under 37 C.F.R. 1.116, filed on 10/26/2005 has been fully considered. And the applicants' remark has been considered.

3. According to the new guideline for 35 U.S.C. 101, the allowability of claim 17 is withdrawn in consideration as set forth above. The rejection is as follows.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-15, and 17-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The method claims include a series of steps without producing a tangible result. It is unclear how the result is being stored, displayed, or used in any tangible manner.

To view the new guidelines for 35 U.S.C. 101, please view the following OG notice.

<http://www.uspto.gov/web/offices/com/sol/oq/2005/week47/patgupa.htm>

As mentioned above, in order to overcome the rejection, claim language should be added that includes displaying, storing, etc.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 10-15, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Krech, Jr. et al (US6779140).

With respect to claim 10, Kerch teach detecting a remote instruction received from a remote controller (figure 2, item 5 through bus controller 88, ring bus, microcontroller to detect remote instruction 22 for testing); upon detecting the remote test instruction, switching from a control mode (local control include control mode that executes test program to be applied to the device (figure 1, blocks 4a, 6a) to control testing of a device, to a slave mode (slave site controller in slave mode condition) to pass through the remote test instruction to a tester (title; figures 1, test system controller through system bus at blocks 2, 3 and 5a, and column 24, lines 26-67; column 28, line 66 to column 29, line 29).

With respect to claims 11-15, 18 Kerch teach passing through the remote test instruction to a tester; applying the remote test instruction to the device; and applying test instruction to a system-on-chip-the remote, and passing through a result of the remote test instruction to the remote controller, compiling the result with plurality of additional results passed through to the remote controller (figure 1, items 2, 3, 4a, and

figure 2, item 5 from test site controller and test site bus, and through blocks 19, 22, 24; and figure 6, column 15, lines 10-25).

Allowable Subject Matter

7. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In combination with other limitations of the related claims. The prior art of record does not disclose wherein detecting a remote test instruction comprises polling a memory shared with the remote controller.

8. Claims 1-4, 8-9, and 19 are allowable over the prior art of record as disclosed in the record for reason for allowance.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Bui whose telephone number is 571-272-2271. The examiner can normally be reached on M-Th from 7am-4pm, and Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Barlow can be reached on 571-272-2269. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BB

6/6/2006

BRYAN BUI
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Bryan Bui', is written below the printed name and title.